

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of Dufour et al. : ANTIROTATION TOOL HOLDER
Group Art Unit 3722 : AND CUTTING INSERT
Serial No. 10/553,277 :
Filed October 13, 2005 : Confirmation No. 6625
Examiner Willmon Fridie, Jr. :

REQUEST FOR RECONSIDERATION OF ENTRY OF AMENDMENTS

Pittsburgh, Pennsylvania 15222
November 30, 2007

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Sir:

Applicants request that the Examiner reconsider and reverse his decision declining to enter the proposed amendments included in Applicants' "Response to Final Office Action" mailed October 15, 2007 ("the Response") in the above-referenced application ("the Subject Application"). In reply to the Response, the Examiner issued an Advisory Action dated October 30, 2007, in which the Examiner refused to enter the proposed claim amendments that Applicants submitted in the Response. The undersigned discussed the Examiner's refusal to enter the proposed amendments with the Examiner by telephone on November 20, 2007, and explained that Applicants wish to have the proposed amendments entered in order to place the Subject Application in better condition for a possible appeal of the current claim rejections. The Examiner indicated that he was inclined to enter the proposed amendments and requested that

Applicants submit a written request for reconsideration. Accordingly, Applicants submit the present Request for Reconsideration.

In the Advisory Action the Examiner states that the proposed amendments will not be entered because they “raise new issues that would require further consideration and/or search.” More specifically, the Examiner states, in the Continuation Sheet of the Advisory Action, that “there is a question as to whether the new limitations are in harmony with the descriptive matter in the specification and is confined to the disclosure.” In response, as discussed on November 20, Applicants note the substance of the claims presented in the Response were previously before the Examiner. Claims 35-41, 44-47, and 61-63 were previously present in the Subject Application in substantially the same forms. With minor exception, the sole amendments made to each of those claims in the Response is merely to amend the claims to recite “a method of making a tool holder” rather than a “cutting tool”. Each of claims 35-41, 44-47, and 61-63 recites features of the cutting tool holder. Those features are clearly described in the Subject Application as filed. For at least these reasons, Applicants submit that the amended claims included in the Response clearly are in harmony with the descriptive matter in the specification and necessarily are confined to the disclosure.

The Examiner further states in the Continuation Sheet that “there is a question raised under 35 U.S.C. 112, second paragraph, whether the new method claims are incomplete for omitting essential steps, such omission mounting to a gap between the steps.” The Examiner cites to MPEP § 2172.01. Applicants fail to see what relevance this MPEP section, entitled “Unclaimed Essential Matter”, has to the amended claims in Applicant’s Response. The MPEP section states:

A claim which omits matter disclosed to be essential to the invention as described in the specification or in other statements of record may be rejected under 35 U.S.C. 112, first paragraph, as not enabling. *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). See also MPEP § 2164.08(c). Such essential matter may include missing elements, steps or necessary structural cooperative relationships of elements described by the applicant(s) as necessary to practice the invention.

Applicants submit that the amended forms of the claims submitted in the Response do not exclude matter or steps that the Applicants have described or otherwise disclosed as being essential to necessary to practice the invention. The Examiner also has not identified or suggested any such excluded essential or necessary steps or other elements. Indeed, each of the amended claims in the Response ultimately depends from claim 32, which was not amended in the Response and which recites the unique tangential milling feature of the method that is described in the specification. Therefore, a question under MPEP § 2172.01 is not raised by the proposed amendments to the claims presented in the Response.

In sum, because the bases listed in the Advisory Action for refusing to enter the proposed claim amendments are not supported, the amendments should be entered in the Subject Application to place the application in better condition for a possible appeal of the Examiner's rejections.

Should the Examiner wish to discuss this matter he is invited to contact the undersigned at the number listed below.

Respectfully submitted,



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